

**REMARKS**

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

**Disposition of Claims**

Claims 1-5 and 30 were pending in the present patent application. By way of this reply, claims 2, 3, and 30 have been cancelled without prejudice or disclaimer. Claim 1 is independent. Claims 4 and 5 depend directly from claim 1.

**Claim Amendments**

Claim 1 has been amended to include the limitations of now-cancelled dependent claim 2. Claim 1 has also been amended for clarification. No new matter has been added by way of these amendments as support for these amendments may be found, for example, in paragraphs [0016], [0050], [0051], and [0055] of the Instant Specification.

**Drawing Amendments**

Figure 8 has been replaced with the attached replacement sheet. In the replacement sheet, reference labels “2a” and “2b” have been removed. No new matter has been introduced by way of this amendment.

**Specification Amendments**

Paragraph [0099] of the Instant Specification has been amended to conform with the amendments made to Figure 8. No new matter has been introduced by way of this amendment.

**Objection to the Declaration**

The Examiner objects to the Declaration because a page is missing from the Additional Data Sheets (ADS). The ADS for the present application has been resubmitted with this response. Accordingly, withdrawal of the objection to the Declaration is respectfully requested.

**Rejections under 35 U.S.C. §103**

Claims 1, 2, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication 2002/0054259 (hereinafter "Funahata"), in view of U.S. Patent No. 5,759,616 issued to Michel et al. (hereinafter "Michel"), in view of JP03-149803A (hereinafter "Tanaka"), and in view of U.S. Patent No. 5,338,782 issued to Corley (hereinafter "Corley"). By way of this reply, claims 2 and 30 have been cancelled without prejudice or disclaimer and thus, the rejection is moot as to those claims. For the remaining claims, for the reasons set forth below, the rejection is respectfully traversed.

As an initial matter, Applicant notes that various combinations of one or more of four references have been used in rejecting the claims of the present application. The purported reconstruction of the claimed invention by reliance on such a large number of references ranging from, for example, disclosing a method of forming a stable thick resistor having a small TCR value (JP03-149803A) to a method for the manufacture of the microstructure elements wherein the sensitive electronic circuits on the substrate are not damaged (U.S. Patent No. 5,759,616) is not appropriate. It is abundantly clearly that the Examiner, using the present application as a guide, has selected isolated features of the various relied-upon references to arrive at the limitations of the claimed invention. Use of the present application as a "road map" for selecting

and combining prior art disclosures is wholly improper. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985) (stating that “[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time”); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (stating that “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . . This court has previously stated that ‘one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’”); *In re Wesslau*, 353 F.2d 238 (C.C.P.A. 1965) (stating that “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art”).

Thus, Applicant respectfully reasserts there is no motivation to combine the cited references. The references are not related to one another, are not directed to solving similar problems, provide no suggestion or motivation to combine their teachings with one another, and, in some cases, are not in the same field of endeavor as the present invention. Thus, Funahata, Michel, Tanaka, and Corley, whether considered separately or in combination, necessarily cannot render the present invention as recited in independent claim 1 obvious. Also, in view of the lack of any teaching within the references themselves to combine each with the other, the combination of Funahata, Michel, Tanaka, and Corley is not proper.

Funahata relates to a liquid crystal display device having an effective function for reflective color display. Funahata explicitly lists the object of their invention as providing a diffused reflector from which the disadvantages of “(1) inferior reproducibility of the fine

rugged pattern, (2) difficulty in patterning the reflecting film, (3) difficulty in forming a color filter on the reflecting film, and so forth” are removed. *See* Funahata, paragraphs 0006-0009.

Michel relates to a process for producing microstructure components on a substrate. Michel explicitly lists the object of their invention as providing “a method for the manufacture of the microstructure elements wherein the sensitive electronic circuits on the substrate are not damaged.” *See* Michel, column 2, lines 21-25.

Tanaka relates to a stable thick film resistor having small TCR value and no offset by curing thermosetting resin to be used at a higher temperature than glass transition temperature after the resin is cured.

Corley relates to a thermosettable resin composition and to the enhancement of the processing properties of bismaleimides. Corley explicitly states that the objects of their invention are to provide new thermoset resin materials and to provide curable additives which reduce the melting and softening points of the bismaleimides yet cure to high-Tg, tough resins. *See* Corley, column 1, lines 35-40.

There is no suggestion in Funahata, Michel, Tanaka, or Corley as to why one skilled in the art presented with the teachings of Funahata would turn to Michel, Tanaka, or Corley. The same is true for all of the teachings of all of the respective references. Thus, because there is no indication expressing desirability to combine the teachings of Funahata, Michel, Tanaka, and Corley cannot be properly combined for 35 U.S.C. § 103 purposes.

The combination of Funahata, Michel, Tanaka, and Corley is improper because it would not be obvious to one of ordinary skill in the art to “pick and choose” select teachings from each of these references to arrive at the teachings of the claimed invention absent the present

application as a guide and/or a suggestion/motivation to combine the references. In view of the above, it is clear that none of the references even contemplate the problem solved or advantage obtained by the present invention as recited in independent claim 1 and fail to provide any motivation to combine their teachings.

The Examiner cannot combine prior art references to render a claimed invention obvious by merely showing that all the limitations of the claimed invention can be found in the prior art references. Instead, there must a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must an indication within the prior art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Further, the present application *cannot be used a guide* in reconstructing elements of prior art references to render the claimed invention obvious. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

Moreover, with respect to the substance of the cited prior art, none of Funahata, Michel, Tanaka, or Corley recognize the problems be solved or the advantages being obtained by the present invention as recited in independent claim 1.

The present invention relates to methods of manufacturing an optical device and reflection plate, each of which is provided with a resin thin film having a micro-asperity pattern. Advantageously, the manufacturing methods of the present invention prevent the resin thin film from losing its shape through softening of the resin thin film in an alignment film forming process. As discussed with reference to an exemplary embodiment in the specification, this advantage is obtained even if the resin thin film is made of polyimide.

Amended independent claim 1 recites, in part, “baking an alignment film on the resin thin film at a temperature lower than the glass-transition temperature to prevent the micro-asperity pattern formed on the surface of the resin thin film from losing shape.” Funahata does not disclose applying an alignment film to the resin using a method that prevents the micro-asperity pattern formed on the surface of the resin from losing shape. Michel, Tanaka, and Corley are entirely silent regarding alignment films and thus cannot disclose what Funahata lacks.

In view of the above, Funahata, Michel, Tanaka, and Corley (i) are not properly combinable, and (ii) whether considered separately or in combination, in view of their failure to recognize the problem solved or advantages obtained by the present invention, cannot render obvious the present invention as recited in independent claim 1 of the present application. Thus, the independent claim 1 of the present application is patentable over Funahata, Michel, Tanaka, and Corley. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Funahata, in view of Michel, Tanaka, Corley and in further view of U.S. Patent No. 5,817,242 issued to Biebuyck et al. (hereinafter “Biebuyck”). By way of this reply, claim 3 has been cancelled without prejudice or disclaimer and thus, the rejection is moot as to that claim. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Funahata, in view of Michel, Tanaka, Corley and in further view of JP 63-269347A (hereinafter “Yamada”). For the reasons set forth below, this rejection is respectfully traversed.

As an initial matter, Applicant notes that various combinations of one or more of five references have been used in rejecting the claims of the present application. The purported reconstruction of the claimed invention by reliance on such a large number of references ranging from, for example, disclosing a method of forming a stable thick resistor having a small TCR value (JP03-149803A) to a method for the manufacture of the microstructure elements wherein the sensitive electronic circuits on the substrate are not damaged (U.S. Patent No. 5,759,616) is not appropriate. It is abundantly clear that the Examiner, using the present application as a guide, has selected isolated features of the various relied-upon references to arrive at the limitations of the claimed invention. Use of the present application as a “road map” for selecting and combining prior art disclosures is wholly improper. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985) (stating that “[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time”); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (stating that “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . . This court has previously stated that ‘one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’”); *In re Wesslau*, 353 F.2d 238 (C.C.P.A. 1965) (stating that “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art”).

For the reasons discussed above, amended independent claim 1 is patentable over Funahata, Michel, Tanaka, and Corley. Yamada, like Funahata, Michel, Tanaka, and Corley, is

silent regarding applying an alignment film to the resin using a method that prevents the micro-asperity pattern formed on the surface of the resin from losing shape. Thus, Yamada does not teach what Funahata, Michel, Tanaka, and Corley lack.

In view of the above, Funahata, Michel, Tanaka, Corley, and Yamada (i) are not properly combinable, and (ii) whether considered separately or in combination, in view of their failure to recognize the problem solved or advantages obtained by the present invention, cannot render obvious the present invention as recited in independent claim 1 of the present application. Thus, the independent claim 1 of the present application is patentable over Funahata, Michel, Tanaka, Corley, and Yamada. Claim 4 depends directly from claim 1 and is allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Funahata, in view of Michel, Tanaka, Corley and in further view of U.S. Patent No. 6,075,652 issued to Ono et al. (hereinafter "Ono"). For the reasons set forth below, this rejection is respectfully traversed.

As an initial matter, Applicant notes that various combinations of one or more of five references have been used in rejecting the claims of the present application. The purported reconstruction of the claimed invention by reliance on such a large number of references ranging from, for example, disclosing a method of forming a stable thick resistor having a small TCR value (JP03-149803A) to a method for the manufacture of the microstructure elements wherein the sensitive electronic circuits on the substrate are not damaged (U.S. Patent No. 5,759,616) is not appropriate. It is abundantly clearly that the Examiner, using the present application as a guide, has selected isolated features of the various relied-upon references to arrive at the limitations of the claimed invention. Use of the present application as a "road map" for selecting



and combining prior art disclosures is wholly improper. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985) (stating that “[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time”); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (stating that “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . . This court has previously stated that ‘one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’”); *In re Wesslau*, 353 F.2d 238 (C.C.P.A. 1965) (stating that “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art”).

As discussed above, amended independent claim 1 is patentable over Funahata, Michel, Tanaka, and Corley. Ono, like Funahata, Michel, Tanaka, and Corley is silent regarding applying an alignment film to the resin using a method that prevents the micro-asperity pattern formed on the surface of the resin from losing shape. Thus, Ono does not teach what Funahata, Michel, Tanaka, and Corley lack.

In view of the above, Funahata, Michel, Tanaka, Corley, and Ono (i) are not properly combinable, and (ii) whether considered separately or in combination, in view of their failure to recognize the problem solved or advantages obtained by the present invention, cannot render obvious the present invention as recited in independent claim 1 of the present application. Thus, the independent claim 1 of the present application is patentable over Funahata, Michel, Tanaka,


Corley, and Ono. Claim 5 depends directly from claim 1 and is allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

**Conclusion**

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 15115/018001).

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Respectfully submitted,

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Attachments

**AMENDMENTS TO THE DRAWINGS**

Please replace Figure 8 with the attached replacement sheet. In the replacement sheet, reference labels “2a” and “2b” have been removed.